

**REMARKS**

In the above-identified Office Action, the examiner has withdrawn the rejections under 35 USC 112 of claim 6, 7, 14, 15, 19, and 21. Further, the rejections under 35 USC Section 102(e) and 103(a) have been withdrawn. Finally, the objections to claims 5, 13, and 17 have been continued. Applicant has amended these claims to resolve the matter. As a result, applicant believes that this objection has been obviated.

In addition to the above, the examiner has rejected claims 1-3, 5-7, 13-15, and 17-22 under 35 USC Section 112, for use of the term "and/or". By the above amendments, this phrase has been eliminated and as such, the claims are considered acceptable in this regard.

Claims 1-3, 5-6, 13-14, 17-18, 20, and 22 have been rejected as being unpatentable over the patent to Nicolas et al. in review of the patent to Sheiness et al. Nicolas teaches a method for the rapid diagnosis of aerobic bacteria which does not differentiate in his method of identifying different bacteria. Instead all samples are treated equally (column 3, lines 19-27). Thus, Nicholas teaches away from treating different samples in a different manner. Sheiness suffers from the same defect, in other words, Sheiness teaches that it is better to treat all samples in the same manner. Sheiness teaches a rapid and simple method for releasing intact nucleic acid from both prokaryotic and eukaryotic cells (column 6, lines 24-27). Sheiness uses a single lysis buffer to lyses all of the bacteria and eukaryotic cells such that they release all of their nucleic acid into the medium.

The examiner refers to passages in Sheiness wherein prior art are discussed, in particular, disadvantages of the prior art. Applicant does not understand the Examiner's use of this discussion of the prior art. It does not teach or suggest the method of Nicolas nor does it teach use of lysis buffer with lysozyme or proteinase K depending on the type of bacteria to be detected, as the examiner states. Thus, a person of ordinary skill in his review of both Nicolas and Sheiness, would not fail to design a method lysis which a method which lysis all samples in an identical fashion pursuant to these teachings.

The examiner refers to a passage in column 9, lines 1-31 of Sheiness et al. for support for a teaching of the differences in lysing gram-negative and gram-positive bacteria in the lysing conditions to release nucleic acids from rigid cell walls of different types of bacteria. However, while Sheiness et al. does teach such differences, Sheiness does not suggest treating these differences in different manners. Thus, there is nothing in either Nicolas or Sheiness which would suggest applicant's specific lysis protocols for the three different types of gram-positive bacteria.

In addition, the applicant notes that claim 1 requires the presence of an enzyme in the lysis buffer. Sheiness teaches that this is not optimal and thus teaches away, stating that it is better to use a lysis buffer

that does not use enzymes (Column 9, lines 47-50). Thus, a person of ordinary skill, if starting from Nicolas, would not design a lysis buffer that has an enzyme if he were to follow the teachings of Sheiness. Claim 1 requires different lysis buffers based on the outcome of a Gram staining and the buffers require an enzyme. A person of ordinary skill could not fail to follow the clear and unambiguous teaching of Sheiness to develop one lysis buffer for all circumstances; as a result, this person of ordinary skill would not develop applicant's invention, having viewed Sheiness.

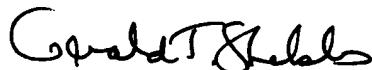
Moreover, a person of ordinary skill would not combine Nicolas with Sheiness because Sheiness is not concerned with *in situ* work. It is not at all concerned with keeping morphology intact. Once nucleic acid is released from the organism only the nucleic acid is ever detected. Nothing else, let alone a morphology, is ever detected. As such, Sheiness does not contain any teaching that would convince a person of ordinary skill aiming to develop a suitable *in situ* approach.

Applicant hereby requests reconsideration and reexamination thereof.

With the above amendments and remarks, this application is considered ready for allowance and Applicant earnestly solicits an early notice of same. Should the Examiner be of the opinion that a telephone conference would expedite prosecution of the subject application, he is respectfully requested to call the undersigned at the below-listed number.

Respectfully submitted,

**WELSH & KATZ, LTD.**



Gerald T. Shekleton  
Registration No. 27,466

Date: April 20, 2005

**WELSH & KATZ, LTD.**  
120 South Riverside Plaza  
22nd Floor  
Chicago, Illinois 60606-3913  
Telephone: 312/655-1500